

REMARKS

Claims 1-22 and 24-39 were pending in the case, prior to the instant Office Action. Claims 24 and 25 were withdrawn from consideration, thus leaving claims 1-23 and 26-39 under prosecution.

On Page 2 of the instant Office Action, lines 3-4, it is stated that claims 32-39 are withdrawn from consideration. It is not clear to Applicants when these claims were withdrawn from consideration since they were added only in the last Amendment (of June 18, 2003) and were presented then following the Examiner's suggestion in the Office Action of May 5, 2003. Applicants believe claims 32-39 are still part of the claims under consideration. Correction accordingly is respectfully requested.

In the instant Office Action, certain parts of the Specification were objected to. This Amendment supplies the missing serial numbers. Claim to the priority provisional application is also included. Applicants believe that this is not new matter.

A missing comma between "piperidyl" and "pyridyl" has been introduced in claim 4, line 5.

In the instant Office Action, claims 1-22 and 26 were rejected under 35 U.S.C. §112, second paragraph, for a double comma. The infraction is corrected now. Withdrawal of §112, second paragraph, rejection is respectfully requested.

In the instant Office Action, claims 28-31 were rejected under 35 U.S.C. §112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention." Page 2 of the Office Action. The Examiner objected to the usage of certain terminologies and phrases in the claims, and, at the same time, kindly suggested deletion of the phrase "therapeutically effective" from the claims. Applicants have adopted the Examiner's suggestions and amended the claims as suggested by the Examiner, while appreciating the Examiner's suggestions. Applicants, therefore, respectfully request withdrawal of the §112, first paragraph, rejection.

Claims 1-2 were rejected under 35 U.S.C. §102(a) as being anticipated by *Marchetti, Synlett.*, 1000-1002 (1999), based on *Marchetti's* compounds 3, 10 and 17. Claims 1-2 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by *Fossli* (U.S. 4,956,344). Claims 1-2 were rejected under 35 U.S.C. §102(b) as

being anticipated by *Reichelt* (U.S. 4,260,601). Claims 1-2 were rejected under 35 U.S.C. §102(e) as being anticipated by *Dressen* (U.S. 6,407,066). Claims 1-2 were rejected under 35 U.S.C. §102(b) as being anticipated by *Koiso* (*J. Antibiotics*, 47, 765 (1994)). Claims 1-2 were rejected under 35 U.S.C. §102(b) as being anticipated by *Laerum* (U.S. 4,499,081). Claims 1-2 were rejected under 35 U.S.C. §102(b) as being anticipated by *Shibuya C.* (JP 53-77083). Claims 1-2 were rejected under 35 U.S.C. §103 as being unpatentable over *Marchetti*. Claims 1-2 were rejected under 35 U.S.C. §103 as being unpatentable over *Marchetti*, or *Koiso*.

Applicants would like to respectfully point out the *Marchetti*, *Koiso*, *Fossli*, *Reichelt*, *Dressen*, *Laerum* and *Shibuya* references only teach compounds that are either carboxylic acid or carboxamide (for R¹ and/or R² of the instant claims). In this Amendment, Applicants have amended the claims so that R¹ and R² are not carboxylic acid, carboxylic ester or carboxamide. Applicants, therefore, believe that all the above-noted rejections are moot now and respectfully request withdrawal of the §112, first paragraph, rejection.

In the present Amendment, Applicants have additionally stipulated that the macrocycle is at least a 11 membered macrocycle, by an added proviso.

Regarding the §103 rejection over *Marchetti*, Applicants would like to respectfully point out that the presently amended compounds are not carboxylic acid, carboxylic ester or carboxamide in the R¹ and R² positions. Applicants, therefore, believe that the size of the R³ moiety (whether it is carboxymethylene, or carboxybutylene etc., see Page 14 of the Office Action) should not have a bearing on the patentability of the instant claims.

Similarly, by excluding carboxylic acid, carboxylic ester or carboxamide in the R¹ and R² positions, Applicants believe that the §103 rejection over *Marchetti* or *Koiso* (page 15 of the Office Action) is moot.

There being no other rejections pending, Applicants believe that the claims, as amended, are in allowable condition and such an action is earnestly solicited. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,



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